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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,610	05/31/2000	Arnold P. Nerenberg	NERE-2842	2861

5409 7590 04/30/2003

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 04/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/584,610

Applicant(s)

NERENBERG ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,12-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10,12-17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____


SAM RIMELL
PRIMARY EXAMINER

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Preliminary Notes

(1) The notice of allowance is hereby vacated. This office action is not made final.

(2) Applicant's Information Disclosure Statement of February 3, 2003 has been received.

A copy of the signed information disclosure statement accompanies this action.

(3) Applicant's declaration under 37 CFR 1.132 accompanying the above Information Disclosure Statement has been received and considered. Examiner's response to this declaration is included at the end of this action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-8, 12-17 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Death Visualization Therapy by Arnold P. Nerenberg, PhD.

Applicability of the Reference: The reference to Death Visualization Therapy is a booklet published by the inventor of record in the present application. Records from the U.S. Copyright Office indicate that a copyright for this booklet was registered on December 27, 1999. A copy of the copyright record obtained from the U.S. Copyright Office pertaining to this same booklet indicates publication on March 20, 1999. Since the publication date of March 20, 1999 is more than one year prior to the effective filing date of the present application, and meets the requirement of being "described in a printed publication" under 35 USC 102(b), the reference to Death Visualization Therapy is considered to be applicable as prior art under 35 USC 102(b).

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Claim 1: Page 8 describes the provision of a coffin in a closed room for the purpose of conducting a psychological therapeutic method. As described on page 19, a first person (Joe's Mother) and a second person (Joe) are brought into the room. The second person (Joe) is directed to lay in the coffin. The first person (Joe's mother) can see the second person (Joe) in the coffin and is directed to speak to the second person (Joe) in regards to their personal relationship. Neither the first person or second person are rehearsing or acting in a theatrical performance.

Claim 4: The first person (Joe's Mother) speaks to the second person (Joe) in regards to an emotion (page 19, lines 12-15)

Claim 5: The steps are performed by a facilitator (page 9, lines 9-13).

Claim 6: The facilitator is a professional therapist. In all the descriptions in the book, the facilitator is Arnold P. Nerenberg, PhD.

Claim 7: The coffin includes a visible pillow (page 8, line 3).

Claim 8: The lower portion of the coffin on the top side is covered or closed (page 8, line 5).

Claim 12: The first person (Joe's Mother) is instructed to speak to the second person (Joe) in regards to specific feelings (page 19, lines 14-15).

Claim 13: Both the first person (Joe's Mother) and the second person (Joe) are questioned after the completion of the session (page 20, line 21; page 15, lines 19-27).

Claim 14: When the first person (Joe's Mother) is directed to speak to the second person (Joe), the first person (Joe's Mother) is speaking to Joe as if he had died and is laying in a coffin, which would be a moment of despair.

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Claim 15: The coffin used in the method serves as a trigger to induce specific thoughts leading to specific new behaviors.

Claim 16: Both the first person (Joe's Mother) and the second person (Joe) are directed to make pledges (page 23, lines 11-12; page 17, lines 1-4; page 17, lines 13-19, page 28, line 7).

Claim 17: The destructive habit primarily described in the Death Visualization Therapy book is parental disrespect, but other behaviors such as drug use and road rage are discussed (page 28, lines 18-20).

Claim 19: See remarks for claim 1. Prior to the implementation of the method, both the first person (Joe's Mother) and the second person (Joe) are questioned (page 6, entire page).

Claim 20: See remarks for claim 4.

Claim 21: See remarks for claim 13.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Death Visualization Therapy, by Arnold P. Nerenberg, PhD in view of Official Notice.

Claims 9-10 differ from the Death Visualization Therapy booklet in that the book does not specifically recite the presence of audio or video devices.

Examiner takes Official Notice that the usage of audio or video devices to record the statements or behavior of individuals is very well known in psychology and psychotherapy.

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It would have been obvious to one of ordinary skill in the art to modify the Death Visualization Therapy method in order to include recording devices so as to permit accurate recording and playback of the patient's behavior, as is well known in the art.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4-10, 12-17 and 19-21 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claims 1 and 19 define a therapeutic method "for improving a relationship between a living first person and a living second person" and define a series of steps for conducting this method. Upon reconsideration, the invention as presently being claimed is considered to be lacking in the requirement for a "useful, concrete and tangible result" from the method steps which are being applied. See MPEP 2106, Section IIA; *State Street Bank & Trust Co. vs. Signature Financial Group Inc.*, 149 F.3d 1368, 1374, 47 USPQ 2d 1596, 1601-02 (Fed. Cir. 1998); *In re Schrader* 22F.3d 290, 297-298, 30 USPQ2d 1455, 1461-62 (Fed. Cir. 1994).

Although the preambles of claims 1 and 19 do define a result of "improving a relationship", this is only a functional recitation of a result. In addition, the result of "improving a relationship" is not considered to define a "useful, concrete and tangible result". Accordingly, claims 1 and 19 lack utility under 35 USC 101. Claims 4-10, 12-17 and 20-21 depend from claims 1 and 19.

Response to Declaration submitted under 37 CFR 1.132

Applicant's declaration has been considered. Applicant states that the Death Visualization Therapy booklet was published on March 20, 1999, but that only a single copy of the booklet was published on that date, and that the single copy was not publicly distributed or otherwise made available to the public.

The question of how many booklets were actually published is considered to be moot, since a statutory bar under 35 USC 102(b) can be established by even one publication made available to the public. See MPEP 2133.03(a); *Ex parte Hershberger* 96USPQ54, 56 (Bd.App. 1952); *Egbert v. Lippmann* 104 U.S. 333, 336 (1881).

Applicant's copyright registration for the Death Visualization Therapy booklet submitted to the US Copyright Office indicate a date of publication of March 20, 1999, more than one year prior to the effective filing date of the present application. By definition, the publication date listed in a U.S. copyright record is "the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease or lending". See *Copyright Registration Form TX*, page 2, section 3 entitled "Creation and Publication"; *Frequently Asked Questions About Copyright*, item #38, "What is publication?". Copies of these references are cited with this action.

Since the date of publication listed in the copyright record is considered to be a distribution of the work to the public, the date of publication listed in the copyright record is not supported by applicant's statements that the booklet was not made public, and establishes the booklet as prior art under 35 USC 102(b).

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell
Primary Examiner
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